

**Notice of Allowability**

Application No.

10/642,947

Examiner

Amelia A. Owens

Applicant(s)

MAGERLEIN, WOLFGANG

Art Unit

1625

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--**

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to amdt filed 4-4-2005.
2. ☒ The allowed claim(s) is/are 2,3,13-20.
3. ☐ The drawings filed on \_\_\_\_\_ are accepted by the Examiner.
4. ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
  - a) ☒ All    b) ☐ Some\*    c) ☐ None    of the:
    1. ☒ Certified copies of the priority documents have been received.
    2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
    3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

5. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
  6. ☐ CORRECTED DRAWINGS ( as "replacement sheets") must be submitted.
    - (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review ( PTO-948) attached
      - 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
    - (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
7. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

1. ☒ Notice of References Cited (PTO-892)
2. ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3. ☐ Information Disclosure Statements (PTO-1449 or PTO/SB/08), Paper No./Mail Date \_\_\_\_\_
4. ☐ Examiner's Comment Regarding Requirement for Deposit of Biological Material
5. ☐ Notice of Informal Patent Application (PTO-152)
6. ☐ Interview Summary (PTO-413), Paper No./Mail Date \_\_\_\_\_
7. ☒ Examiner's Amendment/Comment
8. ☒ Examiner's Statement of Reasons for Allowance
9. ☐ Other \_\_\_\_\_.

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**EXAMINER'S AMENDMENT**

An examiner's amendment to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

*The application has been amended as follows:*

**Claim 13** (page 4) line 5 delete 'the'

**Claim 14** line 2 delete 'the'

**Claim 15** line 2 delete 'the'

**Claim 16** (page 5) line 2 delete 'the'

Line 6 replace 'claim 10' with ---claim 13---

**Claim 17** line 2 delete 'the'

Page 6 line 3 replace 'claim 10' with ---claim 13---

**Claim 19** (page 7) line 6 replace 'claim 10' with ---claim 13---

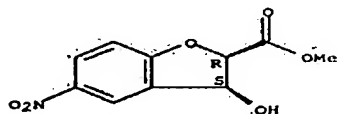
Line 10 replace 'claim 10' with ---claim 13---

*The changes were made to obviate potential 35 USC 112, 2<sup>nd</sup> paragraph rejection.*

**REASONS FOR ALLOWANCE**

The following is an examiner's statement of reasons for allowance: Claims 1, 4-12 and 21-26 have been canceled. Claims 2,3,13-20 are pending.

The prior art neither teaches nor suggests the claimed compound. 5-nitrobenzofuran compounds are known. The prior art compounds differ from the claimed compounds by the presence of a CO(O)alkyl instead of an alkyl at the 2-position. See Suzuki CA 110:94892 (already of record) that teach RN 119197-68-1 shown below. There is no motivation to replace the CO(O)alkyl with an alkyl at the 2-position.



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Some of the compounds also have an alkyl at the 3-position, see RN 119197-71-6.

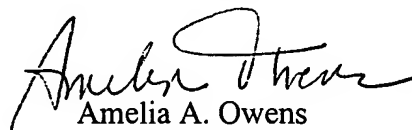
Regarding the process of preparing the compound, the prior art uses different reactants and reaction mechanism to arrive at formula I compounds. Novelty resides in reducing the carboxyl to the alcohol; then dehydrating the alcohol to get the compound of formula I (claim 13). See Horaguchi et al CA 108:75142 and Suzuki CA 105:190808 that teach producing 5-nitrobenzofuran compounds. Note that the processes of the prior art do not contain a carboxyl to undergo reduction to the alcohol. For the above reasons, the claims are neither taught nor suggested by the prior art and are allowed.

Any comments considered necessary by applicant must be submitted no later than the payment of the issue fee and, to avoid processing delays, should preferably accompany the issue fee. Such submissions should be clearly labeled "Comments on Statement of Reasons for Allowance."

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amelia A. Owens whose telephone number is 571-272-0690. The examiner can normally be reached on Monday - Friday from 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Cecilia Tsang can be reached on 571-272-0562. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Amelia A. Owens  
Primary Examiner  
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